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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,301	03/23/2000	Maximino Aguilar	AUS000149US1	1358

39698	7590	01/10/2005	

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EXAMINER
AMSBURY, WAYNE P

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr>
<td rowspan="2"><i>Office Action Summary</i></td>
<td>Examiner</td>
<td>Art Unit</td>
<td rowspan="2"></td>
</tr>
<tr>
<td>Wayne Amsbury</td>
<td>2161</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 July 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

CLAIMS 1-41 ARE PENDING

1. Please supply the application number and status of the co-pending application

incorporated by reference.

2. The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

Claims 1-41 are rejected under the judicially created doctrine of obviousness-

type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.

6,687,819. Although the conflicting claims are not identical, they are not patentably

distinct from each other because they differ in minor ways that would be obvious

alterations for one of ordinary skill in the art at the time of the invention.

As an example, consider claim 1 of the instant application and claims 1-10 of

'819. The major distinctions between claim 1 and claim 1 of '819 are: (1) a set of

partitions of a storage device are searched in claim 1, whereas claim 1 of '819 is silent

on this issue, and (2) claim 1 identifies a plurality of operating systems, rather than a

single one.

However, claims 7-8 of '819 amend the parent claim to deal with a plurality of

operating systems. As to (1), claim 8 is directed to "selecting" an operating system;

claim 27 is directed to "identifying" a plurality of operating systems; claim 28 is directed

to "looking at the boot block". All of these are general statements from which a search

operation may be inferred, and it would have been obvious to one of ordinary skill in the

art at the time of the invention to formalize the identification operation as a search.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 28 and 38-41 are rejected under 35 U.S.C. 102(e) as being

anticipated by Madden et al (Madden), US 6,178,503, 23 January 2001.

As to **claims 28 and 38, Official Notice** is taken that when a storage device

such as a hard disk is partitioned, a partition table identifies the type of file system used

for each partition and identifies whether the partition is bootable. (See, for instance,

Microsoft Computer Dictionary, 4th Edition, 1999.) It follows that *instructions that access*

a partitioned disk identify a plurality of file systems on a storage device, each one of the

plurality of file systems being associated with a partition of the storage device.

It is clear that the act of loading an operating system from a partitioned storage device includes instructions that do this.

Further, a bootable partition is inherently associated with one or more operating systems by the meaning of *bootable*. Thus access to a bootable partition in order to boot a system includes *identifying an operating system associated with a file system on a bootable partition.*

Madden teaches the use of a *plurality of operating systems associated with the plurality of file systems in storage* [COL 1 line 66 to COL 2 line 5 and elsewhere]. The instructions that provide for user selection are clearly a separate set of instructions from those used for access as discussed above and the identification of a plurality of operating systems [TECHNICAL BACKGROUND]. The loading process itself must follow the selection process.

As to **claim 39**, the default choice [COL 1 lines 60-64] corresponds to selection of an OS with the highest priority. As to **claims 40-41**, the application of user choice by menu modifies the priorities.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1-27 and 29-37 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Madden et al (Madden), US 6,178,503, 23 January 2001.

As to **claim 29**, Madden does not specify that loading of a file system descriptor

block is included with the first instructions. However, in order to provide the user with a

choice of operating systems and their associated file systems, a description needs to be

displayed. It would have been obvious to one of ordinary skill in the art at the time of the

invention to load a file descriptor block with each file system in order to at least provide

the information required for display.

As to **claim 30**, Madden teaches that a Boot Manager that provides for choice of

operating system has a default choice, which corresponds to a preferred operating

system [COL 1 lines 60-65; COL 4 lines 16-24].

As to **claim 31**, It would have been obvious to one of ordinary skill in the art at

the time of the invention to identify a boot sector of an operating system with the second

set of instructions because this identification is required for booting the OS and differs

from one OS to another.

As to **claim 32**, Madden notes that a booting system may load a kernel [COL 2 line 65 to COL 3 line 26], and suggests that such a kernel can be used to reduce boot option complexity.

As to **claims 33-34**, these are addressed to the use of a second plurality of operating systems corresponding to one file system. This is addressed in Madden by providing a pre-rendering menu for options that allows one of a plurality of operating systems to be chosen before a complete boot is carried out [COL 3 lines 40-48]. This corresponds to the association of a single file system with a plurality of operating systems.

As to **claims 1 and 14**, Madden does not explicitly state that partitions are determined by searching by a boot code. However, the use of a uniform menu for multiple operating systems during pre-rendering [COL 4 lines 16-24] requires that the operating systems and their associated partitions and file systems be located. This process is clearly carried out by a portion of boot code. It would have been obvious to one of ordinary skill in the art at the time of the invention to search a set of partitions of a storage device in order to locate this information because it is required in order to provide the menu of choices given by Madden.

As to **claim 6**, Madden recognizes that his method may be implemented on a network [COL 1 lines 40-8].

The elements of **claims 2-5, 7-13, 15-27 and 35-37** are rejected in the analysis above and these claims are rejected on that basis.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

WAYNE AMSBURY
PRIMARY PATENT EXAMINER